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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/649,894 | 08/26/2003 | Benoit Reiss | 02-4-148 | 5639 |
| 7590 Carlo S. Bessone OSRAM SYLVANIA INC. 100 Endicott Street Danvers, MA 01923 | | | EXAMINER TON, ANABEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2875 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 02/26/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/649,894 | | REISS, BENOIT | |
| | Examiner | | Art Unit | |
| | Anabel M. Ton | | 2875 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Vadseth (4,910,649).

3. "A cargo lamp assembly for vehicles" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Vadseth discloses an light source having an aperture for emitting a light beam in an arc of about 120 degrees in horizontal and vertical planes (fig 5, light emission surrounding light source 5 appears to be emitted in an arc of about 120 degrees) and a lens (17) for receiving the beam and reducing the beam to 20 degrees (21) in the horizontal and vertical plane. Vadseth does not disclose the lens reducing the beam to about 60 degrees in a horizontal and vertical plane as well as disclosing the light source is a white LED.

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- With regards to the light source being a white LED, the examiner takes Official Notice that the use of LEDs is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an LED for the light source in the system of Vadseth. One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.
- With regards to the lens of Vadseth reducing the beam in a horizontal and vertical plane to about 60 degrees, It would have been obvious to one of ordinary skill in the art as the time the invention was made to do so since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only ordinary skill in the art. *In re Aller*, 105 USPQ 233. In this case, applicant has not disclosed in the specification the criticality of reducing the angle to about 60 degrees in the horizontal or vertical, therefore, one of ordinary skill would have been motivated to modify the lens of Vadseth to reduce the light emission to about 60 degrees to illuminate a desired area within the 60 degrees which would provide a wider range of illumination than that of Vadseth.

Allowable Subject Matter

4. Claims 8-10 are allowed.
5. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The following is a statement of reasons for the indication of allowable subject matter: The prior art cited does not anticipate individually nor teach in combination the limitations regarding the light emission as modified by the lens in claims 2,8,9 and 10.

Response to Arguments

7. Applicant's arguments filed 11/13/06 have been fully considered but they are not persuasive. To being, applicant argues that Vadseth does not teach or remotely suggest "a cargo lamp assembly" as defined in claim 1. Applicant is reminded that the term "cargo light assembly" only appears in the preamble and this term by no means defines any type of structure other than a light source and a lens (as claimed), the lens reducing the angle of light emitted from the light source. In the case of Vadseth, a light assembly is claimed with a housing and a light source emitting light at a wide angle and this light emission being reduced by a lens in front of the light source to a desired reduced angle of light emission. The light source of Vadseth emits light at wide angle as shown in figures 1,3 and 5, and lens 17 reduces this angle to 20 degrees (-10, +10 from the vertical), the light emission as shown in figure 5, clearly shows that the light emitted by the light source falls within the range of 120 degrees inherently in the horizontal and

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vertical planes since the device of Vadseth is not two dimensional. Applicant argues that *In re Aller* does not constitute an appropriate citation of case law with respect to the instant application since *In re Aller* relates to a process for the production of phenol. For applicant's convenience a section from MPEP 2100 under "optimization of ranges" has been provided as follows:

"Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert.

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denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed.Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)."

Since *In re Aller* clearly states that "generally differences of concentration or temperature will not support the patentability of subject matter encompassed by prior art unless there is evidence indicating such concentration of temperature is critical", in the case of the instant invention this case law is applicable since the difference between the instant invention and Vadseth does not lay in that Vadseth discloses an "airfield light" and the instant invention discloses a "cargo lamp assembly", but that the claimed structure of the instant invention (i.e. light source emitting light at a large angle being reduced to a smaller angle by a lens placed in front of the light source) only differs from Vadseth in that the instant invention's light source emits light at 120 degrees in a horizontal and vertical plane and then is reduced by a lens to 60 degrees in a horizontal and vertical plane. Clearly the case law of *In re Aller* was not intended to only apply to instances where concentrations or temperatures were present, but the difference of ranges between a particular characteristic of a limitation of a claimed invention and that of the prior art. For these reasons, applicant's arguments with regards to the applicability of *In re Aller* to the rejection of claim 1 are not persuasive. With regards to applicant's statement that "there is no reason for requiring a showing "criticality" of a limitation which finds support in the original disclosure and which was never alleged to be critical", while the examiner agrees with this statement that it is to the applicant's discretion whether or not to show "criticality", applicant is reminded that although a

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statement of criticality is not required, the features of claim 1 are still not considered allowable at least for the reasons stated above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M. Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

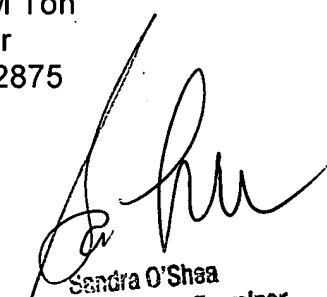
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anabel M Ton
Examiner
Art Unit 2875

AMT



Sandra O'Shea
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